

REMARKS

Claims 2-10, 12-35, 37-40 and 45-51 are pending after this amendment. By this amendment, claims 1, 11, 36 and 41-44 are cancelled, claims 2, 15, 18, and 20 are amended, and claims 45-51 are added. No new matter is introduced. Claims 2 and 20 are amended to incorporate subject matter from canceled dependent claims 11 and 36, respectively, and therefore do not necessitate a new search. Claims 15 and 18 are amended to be placed in independent form, and therefore do not necessitate a new search. Claims 1 and 41-44 are canceled to expedite allowance and to reduce the additional claims charged for adding claims 45-51. The subject matter of new claims 45-51 is supported by the original claims, the figures, and throughout the specification. New claims 45-51 are allowable because the cited art does not disclose the method for providing dedicated online-accessible document storage and handling services or the computerized method for compiling and maintaining litigation-related documents as claimed therein. The above amendments are not intended to, and indeed do not, surrender any range of equivalents. Re-examination and allowance of these claims are respectfully requested.

Claim Rejections Under 35 U.S.C. §101

Claims 2, 41 and 43 are rejected under 35 U.S.C. §101. The Office Action rejects these claims as “not within the technological arts.” Applicant submits that this is not the test under §101. Instead the test is whether the invention produces a “useful, concrete, and tangible result.” *AT&T Corp. v. Excel Communications Inc.*, 172 F.3d 1352, 1355-61, 50 USPQ2d 1447, 1451-54 (Fed. Cir. 1999) (stating that a number of prior tests are no longer applicable – the only valid test is “useful, concrete, and tangible result”); *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d 1368, 1374, 47 USPQ2d 1596, 1601-02 (Fed. Cir. 1998). *Ex parte Bowman*, 61 USPQ2d 1669 (Bd. Pat App. & Inter. 2001) is not binding precedent (see page 1670, “The Board of Appeals and Interferences has indicated that this decision was not written for publication, and is not binding precedent of the Board.”) and may not be relied upon where it conflicts with Federal Circuit precedent. Nonetheless, Applicant’s amendment to claim 2 and the cancellation of claims 41 and 43 renders this rejection moot. Withdrawal of this rejection is respectfully requested.

Claim Rejections Under 35 U.S.C. §102

Claim 1 is rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,987,498 to Athing (“Athing”). The cancellation of claim 1 for claim fee purposes renders this rejection moot.

Claim Rejections Under 35 U.S.C. §103

Claims 2-10, 12-35, 37-40 are rejected under 35 U.S.C. §103(a) as being obvious over Athing in view of U.S. Patent No. 6,098,070 to Maxwell (“Maxwell”). Applicant respectfully traverses these rejections. To establish a *prima facie* case of obviousness ... the prior art reference (or references when combined) must teach or suggest all of the claim limitations. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) and MPEP § 2142. When combined, Athing and Maxwell fail to teach or suggest all of the claim elements of claims 2-10, 12-35, 37-40.

For example, Athing and Maxwell fail to disclose “a computerized method for compiling and maintaining litigation-related documents, comprising ... providing one or more uniform templates for presentation of the litigation-related documents,” as recited in claim 2. The feature of providing one or more uniform templates for presentation of the litigation-related documents is incorporated in claim 2 from original claim 11. With regards to claim 11, the Office Action cites Athing Figure 16 and Maxwell Figure 29, element 2915 as teaching “permitting the downloading of the documents in a plurality of formats” (see page 7 of the Office Action). This alleged teaching of Athing and Maxwell is not relevant to, and does not teach or suggest, the providing of one or more uniform templates for presentation of the litigation-related documents. Indeed, nowhere does Athing and Maxwell, alone or in combination, teach or suggest providing one or more uniform templates for presentation of the litigation-related documents. Therefore, claim 2 is not rendered obvious by Athing and Maxwell. Withdrawal of this rejection and allowance of claim 2 are respectfully requested.

Claims 3-14, 16 and 17, which depend on claim 2, are allowable for at least the same reasons as recited above and for the independent features they recite. For example, Athing and Maxwell do not teach or suggest “wherein the maintaining step includes maintaining the litigation-related documents as a neutral third party with respect to the representatives,” as recited in claim 10. With regards to claim 10, the Office Action cites col. 2, lines 18-26 of Maxwell as disclosing “third parties.” This alleged disclosure, however, does not teach or suggest the claimed feature of maintaining the litigation-related documents as a neutral third party with respect to the representatives. To render a claim obvious, the combination must teach or suggest all of the claim limitations. There is no teaching or suggesting regarding a neutral third party or a neutral third party maintaining litigation-related documents. Therefore, claim 10 is additionally allowable for at least this reason.

Likewise, Athing and Maxwell do not teach or suggest:

charging a fee includes charging one or more of the following: a flat fee based upon a time period; a fee based upon time of use; a fee based upon downloading of the litigation-related documents; a fee based upon uploading of the litigation-related documents to the central repository; or discounted fees based upon particular criteria related to the users,

as recited in claim 14, “permitting a user to select options to access on-line the litigation-related documents, the options including paying a fee and not agreeing to receive on-line advertisements, and paying no fee and agreeing to receive the on-line advertisements,” as recited in claim 16, or “providing users with on-line advertisement space at no fee or at a reduced fee in exchange for the users agreeing to require others to use the central repository,” as recited in claim 17. With regards to claims 14, 16, and 17, the Office Action cites Figure 11 and corresponding text of Athing as disclosing “charging a fee for the on-line access.” This alleged disclosure, however, does not teach or suggest the claimed features recited above. Again, to render a claim obvious, the combination must teach or suggest all of the claim limitations. Therefore, claims 14, 16 and 17 are additionally allowable for at least these reasons.

Athing and Maxwell also fail to teach or suggest “hyperlinking the litigation-related documents with information referenced in the litigation-related documents,” as recited in claim 18. With regards to claim 18, the Office Action cites col. 2, lines 39-43 as disclosing “hyper linking a document,” and states that “an e-mail document in a web-based environment is the hyperlink.” First, this alleged disclosure does not teach hyperlinking the litigation-related documents with information referenced in the litigation-related documents. To render a claim obvious, the combination must teach or suggest all of the claim limitations. There is no teaching, for example, of hyperlinking with information referenced in the litigation-related documents. Second, an e-mail document in a web-based environment is not a hyperlink. Hyperlinking is a term understood to one of ordinary skill in the art and Athing does not teach hyperlinking. Therefore, claim 18 is allowable.

Athing and Maxwell also fail to teach or suggest “permitting a user to access on-line the litigation-related documents in the central repository in exchange for the user's agreement to receive on-line advertisements,” as recited in claims 15 and 20. With regards to claims 15 and 36 (the subject matter of which was incorporated in claim 20), the Office Action cites col. 8, lines 8-20 of Athing as disclosing “advertisements.” This alleged disclosure, however, does not teach permitting a user to access on-line the litigation-related documents in the central repository in exchange for the user's agreement to receive on-line advertisements.

Once again, to render a claim obvious, the combination must teach or suggest all of the claim limitations. Therefore, claims 15 and 20 are allowable.

Claims 21-35 and 37-40, which depend on claim 20, are allowable for at least the same reasons as recited above and for the independent features they recite. For example, Athing and Maxwell do not teach or suggest “maintaining the litigation-related documents as a neutral third party with respect to the representatives,” as recited in claim 31, for the same reasons as discussed above with regards to claim 10. Likewise, Athing and Maxwell do not teach or suggest “providing one or more uniform templates for presentation of the litigation-related documents,” as recited in claim 32, for the same reasons as discussed above with regards to claim 2. Additionally, Athing and Maxwell do not teach or suggest:

charging a fee includes charging one or more of the following: a flat fee based upon a time period; a fee based upon time of use; a fee based upon downloading of the litigation-related documents; a fee based upon uploading of the litigation-related documents to the central repository; or discounted fees based upon particular criteria related to the users,

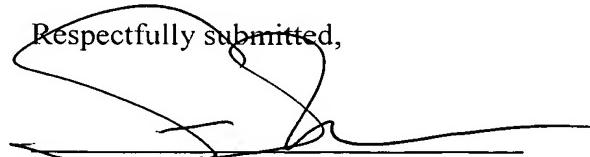
as recited in claim 35, “permitting a user to select options to access on-line the litigation-related documents, the options including paying a fee and not agreeing to receive on-line advertisements, and paying no fee and agreeing to receive the on-line advertisements,” as recited in claim 37, or “providing users with on-line advertisement space at no fee or at a reduced fee in exchange for the users agreeing to require others to use the central repository,” as recited in claim 38, for the same reasons as discussed above with regards to claims 14, 16, and 17. Further, Athing and Maxwell do not teach or suggest “hyperlinking the litigation-related documents with information referenced in the litigation-related documents,” as recited in claim 39 for the same reasons as discussed above with regards to claim 18. Consequently, claims 31, 32, 35, and 37-39 are additionally allowable for at least these reasons.

In view of the above remarks, Applicant respectfully submits that the application is in condition for allowance. Prompt examination and allowance are respectfully requested.

Should the Examiner believe that anything further is needed for allowance, the Examiner is requested to contact Applicant's undersigned representative at the telephone number listed below.

Date: February 10, 2005

Respectfully submitted,



Sean S. Wooden

Registration No. 43,997

Andrews Kurth LLP

1701 Pennsylvania Ave, N.W.

Suite 300

Washington, DC 20006

Tel. (202) 662-2700

Fax (202) 662-2739